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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,058	06/27/2003	Tadashi Hasebe	45355	4152

1609 7590 09/14/2005
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EXAMINER

RONESI, VICKEY M

ART UNIT PAPER NUMBER

1714

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,058

Applicant(s)

HASEBE ET AL.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-6 and 8-16 are now pending in the application.
2. The objections to the specification and claims 1-5 are withdrawn in light of applicant's amendment filed 6/29/2005.
3. The 35 USC 112(1) and 112(2) rejections and the 35 USC 102(b) prior art rejection are withdrawn in light of applicant's amendment filed 6/29/2005.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
5. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

Claim Objections

6. Claim 6 is objected to because of the reasons given in paragraph 6 of the Office action mailed 3/29/2005.

Claim Rejections - 35 USC § 103

7. Claims 1-6, 8-10, and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kakizawa et al (US 6,110,578) in view of Hayashida et al (US 5,346,944) and Okumura et al (US 6,582,813).

The rejection is adequately set forth in paragraph 10 of Office action mailed 3/29/2005 and is incorporated here by reference.

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8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kakizawa et al (US 6,110,578) in view of Hayashida et al (US 5,346,944) and Okumura et al (US 6,582,813).

The rejection is adequately set forth in paragraph 11 of Office action mailed 3/29/2005 and is incorporated here by reference.

Response to Arguments

9. Applicant's arguments filed 6/29/2005 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Kakizawa et al fails to provide the necessary incentive to use two different antistatic agents; (B) that Hayashida et al, which only discloses polyolefin compositions, provides no motivation to use its antistatic agents in a biodegradable polyester obtained from lactic acid; (C) that there is no suggestion in Okumura et al that the identified antistatic agents are equivalents and equally effective; and (D) that the inventive and comparative data as originally filed clearly demonstrate that the combination of an alkyl sulfonate and a glycerin fatty acid monoester has greatly improved and unexpected antistatic properties

With respect to argument (A), while Kakizawa does not explicitly teach the use of mixtures of antistatic agents, case law holds that it is *prima facie* obvious to combine two ingredients, each of which is targeted by the prior art to be useful for the same purpose. *In re Lindner* 457 F.2d 506,509, 173 USPQ 356, 359 (CCPA 1972).

With respect to argument (B), while Hayashida et al only discloses polyolefin compositions, it is the examiner's position that an antistatic agent useful polyolefins would be equally expected to provide antistatic effects in other resins. Evidence to support the examiner's

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position is found in Okumura et al which discloses polyester composition and teaches the use of identical antistatic agents as those utilized in the polyolefin composition of Hayashida et al.

With respect to argument (C), given that Okumura teaches the effectiveness of alkyl sulfonates and alkyl diethanolamides at reducing surface resistance, alkyl sulfonates and alkyl diethanolamides are functional equivalents with respect to imparting antistatic effects.

Moreover, note that Hayashida et al teaches that esters of glycerin with higher fatty acids are known to be combined with other antistatic agents to prevent coagulation (col. 1, lines 50-68) and that amine-type antistatic agents are disadvantageous due to subsequent yellowing. While Hayashida et al suggests and exemplifies alkyl diethanolamides as the antistatic agent mixed with the fatty acid esters, Hayashida et al does not teach away from using other non-amine containing antistatic agent. Therefore, it would have been obvious to one of ordinary skill in the art to utilize other non-amine containing antistatic agents such as alkyl sulfonates with fatty acid esters and thereby arrive at the presently claimed invention.

With respect to argument (D), applicant's data are not commensurate in scope with the presently claimed invention and therefore cannot be utilized to establish unexpected results for the presently claimed ratio ranges. In particular, applicant have shown only a difference between the use of a singular antistatic agent and the use of two in a 50:50 ratio in a composition containing glycerol monolaurate and alkyl sulfonate. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983).

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Conclusion

10. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/6/2005

vr




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